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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte REINER BARTSCH

Appeal 2009-014756
Application 10/625,582
Technology Center 1700

Before ADRIENE LEPIANE HANLON, TERRY J. OWENS, and BEVERLY A. FRANKLIN, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 32-46. We have jurisdiction under 35 U.S.C. § 6(b).

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Claims 32 and 36 are representative of the subject matter on appeal and are set forth below:

32. A method of making a small glass container, said method comprising the steps of:

a) clamping a hollow glass tube with an open upper end and an inner surface in a vertical orientation, said hollow glass tube having an alkali release during thermal processing of the hollow glass tube;

b) thermally cutting said hollow glass tube clamped in said vertical orientation in step a) to length, thereby forming a tube piece for discard and a bottom of said hollow glass tube clamped in said vertical orientation in step a);

c) thermally opening said bottom of said hollow glass tube formed in step b) by heating said bottom; and

d) partially closing said open upper end of said hollow glass tube with a stopper provided with a through-going opening, wherein said through-going opening is dimensioned so that an overpressure is produced by constricting a gas flow path through said open upper end during said thermal processing, but so that said open upper end is kept sufficiently open so that an excessive overpressure that would otherwise damage the glass tube is not produced, said thermal processing including said thermally cutting to length and said thermally opening said bottom;

whereby contamination of said inner surface by said alkali release during said thermal processing is at least reduced.

36. A method of making a small glass container, said method comprising the steps of:

a) clamping a hollow glass tube with an open upper end and an inner surface in a vertical orientation, said hollow glass tube having an alkali release during thermal processing of the hollow glass tube;

b) thermally cutting said hollow glass tube clamped in said vertical orientation in step a) to length, thereby forming a tube piece for discard and a bottom of said hollow glass tube clamped in said vertical orientation in step a);

c) thermally opening said bottom of said hollow glass tube formed in step b) by heating said bottom; and

d) blowing gas into the hollow glass tube through said open upper end of said hollow glass tube and through the hollow glass tube so that an overpressure is produced during said thermal processing of said hollow glass tube, said thermal processing including said thermally opening said bottom and said thermally cutting to length;

so that contamination of said inner surface of said hollow glass tube by said alkali release during thermal processing is at least reduced.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

BENNETT	3,985,535	Oct. 12, 1976
SCHUL	4,010,022	Mar. 1, 1977
RITT	4,516,998	May 14, 1985
OTT	US 2004/0176237 A1	Sep. 9, 2004

THE REJECTION(S)

1. Claims 32-39 and 41-46 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

2. Claims 32-35 and 40-41 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ritt in view of Bennett.

3. Claims 36-39 and 42 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ritt in view of Bennett and Schul.

4. Claims 43 and 44 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ritt in view of Ott.

5. Claims 45 and 46 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ritt in view of Ott and Schul.

ANALYSIS
(with Findings of Fact and Principles of Law)

1. The Rejection of Claims 32-39 and 41-46 under 35 U.S.C. §112, second paragraph, as being indefinite

The Examiner's position is that claims 32, 36, 41, 42, 43, and 45 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps. The Examiner asserts that the omitted steps are the linking step between forming a bottom and opening the bottom. Ans. 3.

We disagree with the Examiner's position. It is self-evident that the phrase "thermally opening said bottom" infers that the bottom is closed or that the bottom is further opened. Therefore, the claim does not need to recite a step of, e.g., "closing said bottom." As exemplary of this position, the background section of Ritt indicates that upon thermal separation of the glass tube, two closed ends are formed. Ritt, col. 1. ll. 25-30. Also, the background section of Appellant's Specification similarly indicates that when glass tubing is cut to length, bottoms are formed. Spec.2:18-20. Hence, it is understood that bottoms are formed, and therefore, we do not

agree that the claims are indefinite for omitting recitation of such a step. "The test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, §112 demands no more." *Miles Lab., Inc. v. Shandon, Inc.*, 997 F.2d 870, 875 (Fed. Cir. 1993) (citation omitted).

In view of the above, we reverse the rejection.

2. The Rejection of Claims 32-35 and 40-41under 35 U.S.C. §103(a) as being unpatentable over Ritt in view of Bennett

We consider claim 32 only based upon Appellant's arguments. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Claim 32

ISSUE

Did the Examiner err in determining that the applied art suggests the claimed invention, in particular, the aspect of "partially closing . . . with a stopper"? We answer this question in the affirmative.

It is not disputed by the Examiner that the applied art does not teach use of a stopper for partially closing the open upper end of the hollow glass tube. The Examiner asserts that the step of using a stopper is equivalent to the step of using a "through-going opening" as disclosed in Ritt, and that therefore such a substitution would have been obvious. Ans. 5, 13. Appellant argues that these two method steps are not equivalent. Br. 28-30.

We note that the Examiner bears the initial burden of factually supporting his conclusion. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). In the instant case, the Examiner does not provide evidence supporting that these two method steps are equivalent. *See* Answer generally.

In view of the above, we, therefore, reverse the rejection.

3. The Rejection of Claims 36-39 and 42 under 35 U.S.C. §103(a) as being unpatentable over Ritt in view of Bennett and Schul

We consider claim 36 only based upon Appellant's arguments. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Claim 36

ISSUE

Did the Examiner err in determining that the applied art suggests the claimed invention, and in particular, the aspect of "blowing gas into the hollow glass tube through said open upper end of said hollow glass tube"? We answer the question in the affirmative.

The Examiner recognizes that Ritt does not teach this aspect of the claimed invention and relies upon Schul for teaching this aspect. Ans. 7. However, the claim requires that the gas is blown into the "open upper end" of the glass tubing. The Examiner, in setting forth his position as set forth on page 7 of the Answer, does not address how Schul teaches that the gas is blown into the open upper end of the glass tubing. In fact, it appears that the gas is blown into the lower end of the glass tubing (forming gas is delivered

through line 11 shown in the figure; Schul, col. 2, ll. 64-68). It is thus apparent that the only teaching or suggestion for modifying Ritt's process so as to achieve the claimed invention is derived from Appellant's own Specification rather than the applied prior art. Therefore, we conclude that the Examiner's rejection is improperly based upon improper hindsight reasoning. *KSR Int'l Co. v. Teleflex Inc.,* 550 U.S. 398, 421 (2007) (The fact finder must be aware "of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning"; citing *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966) (warning against a "temptation to read into the prior art the teachings of the invention in issue")). *See also, W.L. Gore & Assocs., Inc. v. Garlock, Inc.,* 721 F.2d 1551, 1553 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

In view of the above, we reverse the rejection.

4. The Rejection of Claims 43 and 44 under 35 U.S.C. §103(a) as being unpatentable over Ritt in view of Ott

Claim 43 is similar to claim 32 by requiring a stopper for partially closing an open upper end of the glass tube. Hence, for the reasons stated *supra*, Ritt fails to suggest this aspect of the claim and Ott does not remedy this deficiency of Ritt.

We, therefore, reverse the rejection.

5. The Rejection of Claims 45 and 46 under 35 U.S.C. §103(a) as being unpatentable over Ritt in view of Ott and Schul

Claim 45 is similar to claim 36 by reciting "blowing gas into said glass tube through said open upper end" of the glass tube. Hence, for the reasons stated *supra*, the combination of Ritt in view of Shul fails to suggest this aspect of the claim, and Ott does not remedy this deficiency of the combination of Ritt in view of Schul.

We, therefore, reverse the rejection.

CONCLUSIONS OF LAW AND DECISION

Each rejection is reversed.

REVERSED

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